

6272-0017-3

"RESPONSE UNDER 37 CFR 1.116-
EXPEDITED PROCEDURE EXAMINING
GROUP 3724"

HB/Rex
for Recons
G.E.
4/16/03
J/GRatt

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

Detlef ALBIN ET AL : EXAMINER: DEXTER, C.

SERIAL NO: 08/650,709 :

RCE FILED: January 7, 2002 :

FOR: DEVICE AND A PROCESS :
FOR COARSELY GRINDING
HYDROUS POLYMER GELS

REQUEST FOR RECONSIDERATION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Applicants respectfully request reconsideration of the final rejection of Claims 2, 12, 13, 18 and 28-30, for the reasons set forth below.

As previously described, in accordance with a feature of the invention the cutting roll is not mounted directly above the backup roll, but is offset such that the smallest distance between the cutting edge of the cross-cutting element of the first cutting roll and the backup roll is situated below and *upstream* with respect to the crown of the backup roll, as viewed in the conveying direction of the layer of hydrous polymer gel to be cut at the nip. This arrangement provides the advantage that the gel layer being cut is supported by the backup roller throughout the cutting operation, and so is less likely to tear before cutting is completed.

Claim 28 had been amended in the response filed on July 22, 2002 to further recite "upstream" feature noted above. The Examiner has objected to this limitation under 35

U.S.C. § 112, second paragraph, as being definite because "the invention is being positively defined in terms of the work piece which is not a part of the claimed invention."

It is noted that Applicants are entitled to "some latitude in the manner of expression and the aptness of terms...even though the claim language is not as precise as the Examiner might desire." MPEP §2173.02. Moreover, a claim element may be defined in terms of an unclaimed element (which may or may not be a workpiece) so long as the characteristics of the unclaimed element would be understood by those skilled in the art. See MPEP §2173.05(b); Ex parte Brummer, 12 USPQ 2d 1653 (PTO Bd. of Pat. App. and Int. 1989); Orthokinetics Inc. v. Safety Travel Chairs, Inc., 1 USPQ 2d 1081 (Fed. Cir. 1986). In Orthokinetics, the leg of a chair was defined in terms of the space between the door frame of an automobile and one of the seats. The Federal Circuit there held that this was an acceptable way of defining a dimension of a claim element, so long as this "is as accurate as the subject matter permits." Here, the inventive feature can only be expressed by reference to the conveying direction of the work piece. Moreover, those skilled in the art would be able to determine a conveying direction. Therefore, defining the relative positions of the rolls in terms of the conveying direction does not render the claims indefinite under 35 U.S.C. § 112, second paragraph.

Applicants further traverse what is evidently a prior art rejection based upon the previously submitted claims which lack the "upstream" limitation, and **not the claims presently being submitted for examination**. After having objected to Claim 28 as being indefinite, due to the "upstream" limitation (see above), the Examiner has also rejected Claim 28 "as understood" under 35 U.S.C. § 102 as being anticipated by Wilson. The Examiner there alleged that Wilson discloses "every structural limitation of the claimed invention" including a smallest distance between the cutting edge and the backup roll being "situated below the crown of the backup roll." No allegation was made that Wilson disclosed the

recited feature of "upstream in a conveying direction of a layer of hydrous polymer gel to be cut at the nip." Thus, it is apparent that the Examiner has simply ignored the limitation of Claim 28 which the Examiner has alleged to be indefinite under 35 U.S.C. § 112.

However, the Examiner is respectfully reminded that "indefinite limitations must be considered . . . A claim limitation which is considered indefinite cannot be disregarded." MPEP § 2143.03. Thus, either Wilson must disclose every limitation of Claim 28, including that which the Examiner considers to be indefinite, or this rejection must be withdrawn.

In fact, as explained in the previous response, Wilson fails to disclose all of the features of Claim 28. Specifically, the backup roller 78 of Wilson is positioned upstream of the cutting drum 102, so that the smallest distance between the cutting drum 102 and the backup roller is located downstream of the crown of the backup roller, as viewed in the conveying direction of the sod, i.e., *the opposite of what is claimed*. Applicants therefore respectfully submit that Claims 28 and 29 clearly define over the prior art.

Applicants therefore believe the present application is in condition for allowance and respectfully solicit an early Notice of Allowability.

Respectfully submitted,

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